



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/774,529	05/05/2010	DANIEL C. WILSON	50196-00153	8189

25231 7590 04/28/2017  
MARSH, FISCHMANN & BREYFOGLE LLP  
8055 East Tufts Avenue  
Suite 450  
Denver, CO 80237

EXAMINER
----------

BROWN, RUEBEN M

ART UNIT	PAPER NUMBER
----------	--------------

2424

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

04/28/2017

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOMail@mfbllaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* DANIEL C. WILSON, DANIEL A. BOULET,  
SANDRO A. TORRIERI, and DEAN T. MICHAELS

---

Appeal 2017-000184  
Application 12/774,529<sup>1</sup>  
Technology Center 2400

---

Before ST. JOHN COURTENAY III, THU A. DANG, and  
LARRY J. HUME, *Administrative Patent Judges*.

HUME, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the final rejection of claims 23–60. Appellants have canceled claims 1–22. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

---

<sup>1</sup> According to Appellants, the real party in interest is Invidi Technologies Corp. App. Br. 1.

## STATEMENT OF THE CASE<sup>2</sup>

### *The Invention*

Appellants' disclosed and claimed inventions relate to a method of planning, purchasing, delivering and monitoring targeted advertising via television. Spec. ¶ 1.

### *Exemplary Claim*

Claim 23, reproduced below, is representative of the subject matter on appeal (*emphases* added to contested limitations):

23. A method for use in connection with delivering targeted assets to subscribers having subscriber equipment in a broadcast network, *the broadcast network primarily involving synchronized distribution of broadcast content to multiple users*, comprising the steps of:

providing a processor based asset targeting system operative to:

obtain, from asset providers, targeting information for assets, said targeting information identifying target audiences for said assets;

obtain audience classification information for subscribers, said audience classification information comprising personal information of said subscribers other than tracking usage of said broadcast network, said personal information including at least one of age, income, and gender for individual subscribers; and

*select assets for delivery to particular subscribers based at least in part on said targeting information and said*

---

<sup>2</sup> Our decision relies upon Appellants' Appeal Brief ("App. Br.," filed Jan. 15, 2016); Reply Brief ("Reply Br.," filed Sept. 27, 2016); Examiner's Answer ("Ans.," mailed July 27, 2016); Final Office Action ("Final Act.," mailed Dec. 15, 2014); and the original Specification ("Spec.," filed May 5, 2010).

*classification information, wherein an asset delivered on a particular occasion is based in part on personal information of a subscriber; and*

said asset targeting system being limited to components involved in one or more of 1) selecting particular targeted assets for delivery to particular subscribers based on personal information of said particular subscribers, 2) effecting delivery of selected targeted assets to particular subscribers based on personal information of said particular subscribers, and 3) reporting delivery of selected targeted assets to particular subscribers based on personal information of said particular subscribers;

*receiving, at said targeting system from one of said subscribers, a consent related to said targeting system, said consent indicating a willingness of said subscriber regarding a use of subject personal information in said asset targeting system such that said targeting system will not use said subject personal information in the absence of said consent.*

#### *Prior Art*

The Examiner relies upon the following prior art as evidence in rejecting the claims on appeal:

Herz et al. ("Herz")	US 5,754,938	May 19, 1998
Hendricks et al. ("Hendricks")	US 6,463,585 B1	Oct. 8, 2002

#### *Rejection on Appeal*

Claims 23–60 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings and suggestions of Hendricks and Herz. Final Act. 8; Ans. 2.

#### CLAIM GROUPING

Based on Appellants' arguments (App. Br. 6–32), we decide the appeal of the sole § 103 rejection of grouped independent claims 23, 34, 45,

and 53 on the basis of representative claim 23. *See* 37 C.F.R. § 41.37(c)(1)(iv). We address the rejection of dependent claims 24–33, 35–44, and 46–52, not argued separately, *infra*.

## ISSUES

Appellants argue the Examiner erred in rejecting claim 23 under § 103(a), as being taught or suggested by the combined teachings of Hendricks and Herz. These contentions present us with the following issues:

Did the Examiner err in finding the cited prior art teaches or suggests contested limitations:

- (i) *the broadcast network primarily involving synchronized distribution of broadcast content to multiple users,*
- (ii) *receiving, at said targeting system from one of said subscribers, a consent related to said targeting system,*

as recited in claim 23? <sup>3</sup>

## ANALYSIS

In reaching this decision, we consider all evidence presented and all arguments actually made by Appellants. We do not consider arguments which Appellants could have made but chose not to make in the Briefs so that we deem any such arguments as waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

We disagree with Appellants' arguments with respect to claim 23, and we incorporate herein and adopt as our own: (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken, and

---

<sup>3</sup> We give the contested claim limitation the broadest reasonable interpretation consistent with the Specification. *See In Re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

(2) the reasons and rebuttals set forth in the Examiner's Answer in response to Appellants' arguments. We incorporate such findings, reasons, and rebuttals herein by reference unless otherwise noted. However, we highlight and address specific findings and arguments regarding claim 23 for emphasis as follows.

Appellants contend, in summary:

- Hendricks doesn't disclose obtaining consent for use of personal information.
- Herz relates to point-to-point networks (where the network knows what you are doing anyway because they are interactive) and only obtains consent to sell your profile to third-parties for use in *other systems*.

Neither reference discloses the claimed subject matter related to obtaining consent to use personal information in the same broadcast network targeting system that obtained the personal information. Neither system evinces any recognition of the expectation of privacy that some subscribers may value in the broadcast network context.

App. Br. 7.

We are not persuaded by Appellants' contentions because Appellants are arguing the references separately. "[O]ne cannot show nonobviousness by attacking references individually where... the rejections are based on combinations of references." *In re Keller*, 642 F.2d 413, 426 (CCPA 1981). Although the Examiner finds Hendricks' withholding of the names of households from demographic information sent to the server may suggest "said targeting system will not use said subject personal information in the absence of consent" (Final Act. 10), the Examiner primarily cites Herz, not Hendricks, for teaching this "consent" limitation. Final Act. 10–11.

However, the Examiner cites Hendricks for all the remaining limitations argued by Appellants, with the exception of the recited consent limitation.

Regarding Appellants' argument concerning the disputed "same broadcast" term, Appellants are arguing limitations not recited in claim 23.<sup>4</sup> We agree with the Examiner that claim 23 does not explicitly recite, "obtaining consent to use personal information in the *same broadcast network* targeting system that obtained the personal information." Ans. 10. We agree with the Examiner because claim 23 does not require the "targeting system" to be confined to the "broadcast network," especially because the claim preamble states "the broadcast network *primarily* involving synchronized distribution of broadcast content to multiple users." Ans. 10–11. Therefore, under a broad but reasonable interpretation, the broadcast network may secondarily involve other types of distribution.

We agree with the Examiner that under a broad, but reasonable, interpretation, the recited "targeting system" encompasses Herz's third party providers that collect personal information from viewers. We agree with the Examiner because the plain language of the claim limitation "targeting system," which does not even appear in Appellants' specification, does not preclude third party providers.<sup>5</sup> Ans. 11.

---

<sup>4</sup> See *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) ("[A]ppellant's arguments fail from the outset because . . . they are not based on limitations appearing in the claims.").

<sup>5</sup> Because "applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee." *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (citation omitted).

Appellants further contend:

A fundamental difference between the claimed invention and the various references cited by the Examiner is that the references involve media distribution in a point-to-point fashion (e.g., over the Internet), whereas the relevant steps of the claimed invention involve an asset targeting system in a broadcast network configured for the synchronized distribution of broadcast content to multiple users. Distribution in a point-to-point fashion is a completely different model than broadcast programming, which distributes media in a one-to-many fashion (e.g., synchronized distribution from a central network platform, such as cable headend to a plurality of televisions, as described in greater detail below).

App. Br. 8.

We are not persuaded by Appellants' contentions, and agree with the Examiner's finding that Hendricks clearly teaches an asset targeting system in a broadcast network. Ans. 12–13, citing Hendricks Fig. 1, col. 1, 52–59, col. 3, 29–31, 42–45, col. 30, 33–36, col. 31, 32–37. In addition to these citations, we observe the very first sentence of Hendricks' Abstract states: "A novel multiple channel architecture is designed to allow targeted advertising directed to television terminals connected to an operations center or a cable headend." Hendricks, Abst.

Appellants also argue Hendricks "teaches away from the invention of claim 23 by suggesting that individualized targeting can be accomplished only through point-to-point architectures, such as the Internet." App. Br. 15–16.

Appellants specifically contend:

In particular, Hendricks does not select assets for delivery to particular subscribers of a broadcast network based on personal information. Of critical note, Hendricks not only fails to teach



selecting assets for delivery to particular subscribers in a broadcast network. Hendricks actively teaches away from this concept by suggesting that targeting advertisement to individual viewers can be accomplished only within a point-to-point architecture.

App. Br. 18.

Our reviewing court guides, "in general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant." *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). We do not find that to be the case here.

We disagree with Appellants' contention because our reviewing court instructs that the mere failure of a reference to mention alternatives known in the art does not constitute a teaching away from using the known elements. *See DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1327 (Fed. Cir. 2009) ("A reference does not teach away [. . .] if it merely expresses a general preference for an alternative invention but does not 'criticize, discredit, or otherwise discourage' investigation into the invention claimed").

Here, we agree with the Examiner that the relevant portion of claim 23 ("select assets for *delivery to particular subscribers* based at least in part on said targeting system information and said classification information, wherein an asset delivered on a particular occasion is based in part on personal information of a subscriber") does not restrict the selecting and delivering of the advertisements as to exclude a point-to-point delivery. Ans. 17. Therefore, we find the recited claim term "delivery" does not preclude the delivery methods taught in Hendricks.

Further, although Appellants raise additional arguments for patentability of claim 23 (App. Br. 6–27), we find that the Examiner has rebutted each of those arguments in the Answer by a preponderance of the evidence. Ans. 8–29. Therefore, we adopt the Examiner's findings, underlying reasoning, and legal conclusions, which we incorporate herein by reference. Consequently, we find no reversible error in the Examiner's rejections of claim 23.

In view of the lack of any substantive or separate arguments directed to the obviousness rejection of dependent claims 24–33, 35–44, 46–52 under § 103 (*see* App. Br. 27–32), we sustain the Examiner's rejection of these claims, as they fall with their respective independent claims. Arguments not made are considered waived.<sup>6</sup>

#### REPLY BRIEF

To the extent Appellants may advance new arguments in the Reply Brief (Reply Br. 2–5) not in response to a shift in the Examiner's position in the Answer, we note arguments raised in a reply brief that were not raised in the appeal brief or are not responsive to arguments raised in the Examiner's Answer will not be considered except for good cause, which Appellants have not shown. *See* 37 C.F.R. § 41.41(b)(2).

---

<sup>6</sup> When Appellants do not separately argue the patentability of dependent claims, the claims stand or fall with the claims from which they depend. *In re King*, 801 F.2d 1324, 1325 (Fed. Cir. 1986).

### CONCLUSION

The Examiner did not err with respect to the obviousness rejection of claims 23–60 under 35 U.S.C. § 103(a) over the cited prior art combination of record, and we sustain the rejection.

### DECISION

We affirm the Examiner's decision rejecting claims 23–60.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED